

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q61464

Chun-un KANG, et al.

Appln. No.: 09/758,127

Group Art Unit: 2111

Confirmation No.: 8900

Examiner: Khanh Dang

Filed: January 12, 2001

For: METHOD OF CONTROLLING PORTABLE PERSONAL DEVICE HAVING
FACILITIES OF STORING AND PLAYING DIGITAL CONTENTS BY
COMPUTER AND PORTABLE PERSONAL DEVICE OPERATION METHOD
THEREFOR

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated November 30, 2004. Entry of this
Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL	3
ARGUMENT	4
CONCLUSION.....	8

STATUS OF CLAIMS

The status of the claims remains unchanged as set forth in Appeal Brief, filed October 12, 2004.

Claims 1-95 are all the claims currently pending in the application, although claims 4-91, 93, and 95 have been withdrawn from consideration. Thus, claims 1, 2, 3, 92, and 94 have been examined.

Claims 1, 2, 3, 92 and 94 are rejected.

The appealed claims are claims 1, 2, 3, 92 and 94.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 92 and 94 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bastiani et al. (US 6,609,167).

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani et al. in view of Kobayashi (US 6,199,122) or in view of Kawamura et al. (US 6,408,350) or in view of Kagle et al. (US 6,601,056).

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani et al. in view of Kobayashi or Kawamura et al. or Kagle et al., in view of Official Notice.

ARGUMENT

With regard to the rejection of claim 92 as being anticipated by Bastiani et al., Appellant argued in the Appeal Brief that Bastiani et al. does not teach or suggest sending from a portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to execute a request command to a computer, when the portable personal device is ready to execute the request command. Further, Appellant argued that although Bastiani et al. discloses that a device responds to the HEARTBEAT packet with an ACK packet if the device is ready and there is no change in media status since the last status read, the response of the device of Bastiani et al. does not correspond to a signal indicating that the portable personal device is ready to execute the request command. The device responds to the HEARTBEAT packet with an ACK packet, which indicates that the device is “ready,” but “ready” in Bastiani et al. does not correspond to “ready to execute the request command” as recited in the claim. The HEARTBEAT packet is used to determine whether a port has had a device attached or removed. If the device is attached and powered, the device should return an ACK. See col. 30, lines 14-18. In Bastiani et al., the device has not received a request command when it responds to the HEARTBEAT packet with an ACK. Rather, the HEARTBEAT packet is used to determine whether a device is able to receive any data. In other words, the HEARTBEAT packet is used to determine whether a device is attached, not whether the device is ready to execute a request command. Determining whether the device is ready to execute a request command would have to be, if it were performed, a subsequent operation to determining whether the device is attached.

In response to these arguments, the Examiner makes the following points.

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 09/758,127

First, in response to Appellant's comment in the Appeal Brief that "the HEARTBEAT packet is used to determine whether a device is able to receive any data," the Examiner contends that "any data" includes the "request command," since "request command" is a form of data. Appellant respectfully submits that the Examiner has missed the point of the argument. Specifically, whether a device is able to receive any data is quite different from the feature of claim 92 of sending ... a signal indicating that the portable personal device is ready to execute a request command.

Second, the Examiner quotes a portion of Bastiani et al., which states that "ACK in the case of HEARTBEAT indicates that the device is powered and able to receive link or device commands from the host." Col. 31, line 67 - col. 32, line 2. Further, the Examiner points out that Bastiani et al. (col. 36, line 61 - col. 37, line 5) discloses that once the host has determined that a device is attached and ready, the host requests configuration information from the device to determine the device's capabilities. However, neither of these disclosures teaches or suggests sending from a portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to execute a request command to a computer, when the portable personal device is ready to execute the request command. That the device in Bastiani et al. is powered and able to receive link or device commands from the host does not mean that the device sends a signal indicating that the portable personal device is ready to execute a request command. Likewise, the host in Bastiani et al. requesting configuration information from the device to determine the device's capabilities does not mean that the device sends a signal

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 09/758,127

indicating that the portable personal device is ready to execute a request command. Such a disclosure is simply not present in Bastiani et al.

For the foregoing reasons, as well as the reasons presented in the Appeal Brief, Appellant submits that claim 92 is not anticipated by Bastiani et al.

For the anticipation rejection of claim 94, the Examiner simply refers back to the discussion of claim 92 and asserts that because Bastiani et al. discloses sending a HEARTBEAT signal, the signal is received by the host. However, as described above in relation to claim 92, Appellant has distinguished the HEARTBEAT packet of Bastiani et al. from the feature of claim 92 of sending ... a signal indicating that the portable personal device is ready to execute a request command. Thus, claim 94 is not anticipated by Bastiani et al.

With regard to the rejection of claims 1 and 2 over Bastiani et al. in view of Kobayashi, Kawamura et al., or Kagle et al. and the rejection of claim 3 over Bastiani et al. in view of Kobayashi or Kawamura et al. or Kagle et al., in view of Official Notice, the Examiner argues in the Examiner's Answer that one cannot show nonobviousness by attacking the references individually where the rejections are based on combinations of references. In response, Appellant points out that only Bastiani et al. was applied by the Examiner as allegedly disclosing certain features of the claims of the present application. Appellant argued in the Appeal Brief that Bastiani et al. does not teach or suggest those certain features. Further, Appellant argued that the secondary and tertiary references also fail to disclose those certain features. Thus, Appellant has not attacked the references individually.

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 09/758,127

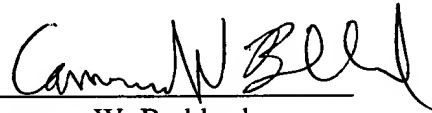
Moreover, the prior art does not disclose the feature of claim 1 of sending from the portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to format to the computer, when the portable personal device is ready to format. The Examiner relies on the teaching of Bastiani et al. of the transmitting of the HEARTBEAT packet and ACK signal discussed above in relation to claim 92, as allegedly disclosing the above-recited feature of claim 1. As described above, neither transmitting the HEARTBEAT packet nor the ACK signal corresponds to sending ... a signal indicating that the portable personal device is ready to execute a request command. Likewise, transmitting the HEARTBEAT packet and the ACK signal do not correspond to sending ... a signal indicating that the portable personal device is ready to format. Rather, the HEARTBEAT packet is used to determine whether a device is attached, and the ACK signal in response to the HEARTBEAT packet indicates if the device is ready and there is no change in media status since the last status read. Accordingly, claim 1 and its dependent claims 2 and 3 are allowable over the prior art.

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 09/758,127

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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